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EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT PAPER NUMBER

2626

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/581,928

Applicant(s)

CASTET ET AL.

Examiner

Madeleine AV Nguyen

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-18 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-3, 5-18 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This communication is responsive to amendment filed on August 11, 2004.

Applicant cancels claim 4, amends the specification, claims 1, 14, 15.

Response to Arguments

1. Applicant remarks that in Keller, the mails are distributed through a data processing system, which is not a computer network, such as the Internet as in present claims 1, 14.

In the Background of the Invention, Keller teaches that "Electronic mail systems allow a user to create a piece of mail electronically and then send it to another user via a data processing system network and the associated user interfaces." (col. 1, lines 12-17). In addition, "The user interfaces 21, 21A, 21B are interconnected together through the central processor 19 so as to form a network. The user interfaces may be directly connected to the central processor or may be connected to the central processor over a telecommunications system." (col. 3, lines 28-33). Thus, in Keller, the mails are distributed through a data processing system which is a computer network.

2. Applicant remarks that in Keller, it is up to the operating system of the data processing system to carry out the action by the recipient only if he has selected the command, and not the terminal, as in claims 1, 14, where the computer network only distributes the electronic mails.

Claim 1 claims "in the receiving terminal, the mail is checked in order to capture the control data, the meaning of the said control data, is sought, and, if appropriate, the execution of

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the said operation is initiated.” The system in Keller does the same way: in the receiving terminal, the control data are captured (.CMD RDRLIST, .CMD PURGE READER ALL), the meaning of the control data are also captured (to view a list of your reader files, ... and press ENTER, to discard all of your reader files, ... and press ENTER, the PF1-PF10 commands with their meanings at the end), if the user selects any command (if appropriate), the execution of the operation is initiated as claimed. Thus, the receiving terminal checks the mail in order to capture the control data, the meaning of the control data before the user select the command for the execution of the operation of the command. Besides, it is noted that the claim does not specifically claim that the receiving terminal does those steps automatically without any input or interference from the user. The same with claim 14.

3. Applicant remarks that Motoyama teaches a combination of a connectionless-mode of transmission (as Internet) between a machine and remote diagnostic station, and a connection mode of transmission in the event the connectionless-mode of transmission is not suitable, so a solution as taught in the pending application or as taught in Keller is avoided.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keller in view of Motoyama since Keller fails to teach that control data for validation of reception is inserted in the message. It is noted that the test for obviousness is not whether the features of the reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the references make obvious to one ordinary skill in the art. In re Bozek, 163 USPQ 545, (CCPA 1969); In re Richman 165 USPQ 509, (CCPA 1970); In re Beckum, 169 USPQ 47 (CCPA 1971); In re Sneed, 710 F.2d 1544, 218 USPQ 385. Keller et al teaches the transmission and reception

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of electronic mail but fails to teach that the receiving email contains control data for transmission of an acknowledgement of reception which is well known in the prior art. Motoyama teaches the transmission and reception of an electronic message wherein "The e-mail message may contain a request for acknowledgement of receipt ..." (col. 8, lines 64-66). Thus, the teaching of Motoyama regarding the request for acknowledgement of receipt make obvious to one ordinary skill in the art to modify the email in Keller including that request since the email in Keller also contains control data for the management of the e-mail.

4. Applicant remarks that Hochman does not disclose any command embedded in a mail, sought and captured by the terminal, in order to execute an action.

Hochman teaches in Fig.2 the use of a header which may otherwise be compatible with the conventional store-and-forward or E-mail transmission system. The header can include different control data such as mail type or E-mail body format such as text message, fax message, audio file, video clip file, etc., or any previously defined field. In Fig.3, the sender constructs an E-mail message body at 16 and at 18 conventional header material is entered for control data. In Fig.5, a sender wishing to send a facsimile store-and-forward message to an intended recipient mailbox directs his facsimile unit to connect to a receiving unit identified by its telephone number and the sub-address of the recipient is entered at 100 to allow it to be passed utilized by the facsimile reception equipment (col. 5, lines 16-21). Thus, Hochman disclose a command embedded in a mail (in the header) sought and captured by the terminal, in order to execute an action (in case of store-and-forward email message).

Therefore, applicant's arguments filed on August 11, 2004 have been fully considered but they are not persuasive. The rejection of claims 1-3, 5-18 is maintained.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 11, 14 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Keller (US Patent No. 5,906,656).

Regarding claim 1, Keller discloses a method of communication by electronic mail between two user interfaces through a computer network (Figs.5-6), where a first user sends an email wherein data controlling the execution of a management operation are entered into electronic mail and the mail is sent to the receiving terminal (40), the mail is checked in order to capture the control data, the meaning of the control data (Fig.2, 3), and if appropriate the execution of the operation is initiated (when the user selects any command), (Abstract; col. 2, line 59 – col. 3, line 35; col. 4, lines 22-59).

Regarding claim 2, Keller discloses that this command is inserted within the message (Fig.2; col. 3, lines 59-60).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keller ('656) in view of Motoyama ('110).

Regarding **claim 5**, Keller discloses the method in the rejection to claim 2 above, but does not disclose expressly that it sends in the control data an acknowledgement of reception and its address for the receiving terminal.

Motoyama discloses that the e-mail message may contain a request for acknowledgement of receipt (col. 8, lines 64-66) and that an e-mail message will transmit its address. That these can be used by the receiving terminal is implied in the ability of the said terminal to send an acknowledgement to the sending terminal.

Regarding **claim 6**, Keller discloses the method in the rejection to claim 2 above, but does not disclose expressly that a mail reference is inserted in the message.

Motoyama has already been shown to contain the mail reference that is used by the receiving terminal and inserted into the acknowledgement, which is taken to be the network address of the transmitting terminal.

Regarding **claims 7-9**, Keller and Motoyama disclose the method in the rejection to claim 6 above, but do not disclose expressly that control data for validation of

reception is inserted in the message and that upon reception of the acknowledgement the meaning of the data is sought and the reception validated.

Motoyama discloses that upon the sending of the message, that there is the capacity of acknowledgement to secure validation of the success of the transmission and that this is done by measuring a predetermined period of time and that if this has occurred, then a change in state causes the mail to be sent again (col. 8, lines 64-66). The specific details of this process are implied within the function of the apparatus used for the communication and verification.

Keller & Motoyama are combinable because they are from the same field of endeavor and thus constitute analogous art, being that of data transmission across a computer network.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have a process of network communication between two terminals, whereby control data is inserted into the message of the e-mail, along with the address of the sender and a request for acknowledgement of reception, with a return mail reference (address), and a means of receiving the confirmation of reception, or otherwise, in its absence during a period of time to have a change in state that results in the resending of the mail.

The suggestion/motivation for doing so would have been that the use of particular modes of communication and handshaking between devices is applicable to any computer network system, regardless of their specific use.

Therefore, it would have been obvious to combine Keller with Motoyama to obtain the invention as specified in claims 5-9.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keller ('656) in view of Motoyama ('110).

Keller discloses the method in the rejection to claim 14 above, but does not disclose expressly that control data for validation of reception is inserted in the message and that upon reception of the acknowledgement the meaning of the data is sought and the reception validated.

Motoyama discloses that upon the sending of the message, that there is the capacity of acknowledgement to secure validation of the success of the transmission and that this is done by measuring a predetermined period of time and that if this has occurred, then a change in state causes the mail to be sent again (col. 8, lines 64-66). The specific details of this process are implied within the function of the apparatus used for the communication and verification.

Keller & Motoyama are combinable because they are from the same field of endeavor and thus constitute analogous art, being that of data transmission across a computer network.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have a terminal to implement a process of network communication between two terminals, whereby control data is inserted into the e-mail, whereby the message data content can be determined, along with a request for acknowledgement of

reception, and a means of receiving the confirmation of reception as a means of validation.

The suggestion/motivation for doing so would have been that the use of particular modes of communication and handshaking between devices is applicable to any computer network system, regardless of their specific use.

Therefore, it would have been obvious to combine Keller with Motoyama to obtain the invention as specified in claim 17.

Claims 3, 10, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keller ('656) in view of Hochman ('685).

Regarding **claim 3**, Keller discloses the method in the rejection to claim 2 above, but does not disclose expressly that the message contains a field of descriptors of the file format with control data inserted. Hochman discloses that the e-mail header (also called control data) includes a field which identifies the character (file format) of the e-mail message portion (col. 3, lines 57-62).

Regarding **claim 10**, Keller discloses the method in the rejection to claim 2 above, but does not disclose expressly that it sends in the control data capabilities of the sending terminal to the receiving terminal, and the receiving terminal sends its capabilities back to the sending terminal.

Hochman discloses that the reception facility performs a check to confirm whether the message type identified in the header is compatible with the recipient's reception apparatus (col. 4, lines 62-66) and that this message type information also

implies the capabilities of the sending apparatus (col. 3, lines 60-62). After the reception, a confirmatory signal may be transmitted back to the sender, so that routines may be provided to process the data file to a format which can be handled by the recipient (col. 5, lines 1-4), which implies that capability information of the receiving apparatus is included in the confirmatory signal.

Regarding claim 12, Keller discloses the method in the rejection to claim 2 above, but does not disclose expressly that the command data for printing is inserted by the receiving terminal to command printing of the message upon reception.

Hochman provides for this in its use of computers that are capable of sending and receiving fax transmissions (col. 1, lines 59-61), since fax machines receive and print the output, and thus is obvious given the provisions disclosed in Hochman.

Regarding claim 13, Keller discloses the method in the rejection to claim 1 above, but does not disclose expressly that information of file format is attached to the message and that the receiving terminal determines if it can properly reconstruct the file and if not to notify the sending terminal of this.

Hochman discloses that the e-mail transmission includes a header field which identifies the character of the e-mail message portion (col. 3, lines 59-62) and that upon reception, the reception facility performs a check to confirm whether the message type identified in the header is compatible (re-constructible) with the recipient's reception apparatus (col. 4, lines 62-66) and that this message type information also implies the capabilities of the sending apparatus (col. 3, lines 60-62). After the reception, a confirmatory signal may be transmitted back to the sender, so that routines may be

provided to process the data file to a format which can be handled by the recipient (col. 5, lines 1-4), which implies that capability information of the receiving apparatus is included in the confirmatory signal.

Keller & Hochman are combinable because they are from the same field of endeavor and thus constitute analogous art, being that of data transmission across a computer network.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have a descriptor field combined with control data; to have a transmission of a message that sends capabilities of the sender and receiver to one another; that the control data contains a command for printing the message; and that given the file format it can be determined if the receiver is able to reconstruct the file and if not that it sends its inability back to the sender.

The suggestion/motivation for doing so would have been that the use of particular modes of communication and data transfer between devices is applicable to any computer network system, regardless of their specific use.

Therefore, it would have been obvious to combine Keller with Hochman to obtain the invention as specified in claims 3, 10, 12 and 13.

Claims 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keller ('656) in view of Hochman ('685).

Regarding **claim 16**, Keller discloses the method in the rejection to claim 15 above, but does not disclose expressly that a data file and the message includes a descriptor field that can be checked by the same means that checks the message.

Hochman discloses that the file has a character identifier (descriptor field) (col. 3, lines 57-62) and that this can be checked when the message is checked when the field is inserted in the address field (col. 4, lines 1-11).

Regarding **claim 18**, Keller discloses the method in the rejection to claim 14 above, but does not disclose expressly that information of file format is attached to the message and that the receiving terminal determines if it can properly reconstruct the file and if not to notify the sending terminal of this.

Hochman discloses that the e-mail transmission includes a header field which identifies the character of the e-mail message portion (col. 3, lines 59-62) and that upon reception, the reception facility performs a check to confirm whether the message type identified in the header is compatible (re-constructible) with the recipient's reception apparatus (col. 4, lines 62-66) and that this message type information also implies the capabilities of the sending apparatus (col. 3, lines 60-62). After the reception, a confirmatory signal may be transmitted back to the sender, so that routines may be provided to process the data file to a format which can be handled by the recipient (col. 5, lines 1-4), which implies that capability information of the receiving apparatus is included in the confirmatory signal.

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Keller & Hochman are combinable because they are from the same field of endeavor and thus constitute analogous art, being that of data transmission across a computer network.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have a terminal to implement a process of network communication between two terminals, whereby control data is inserted into the e-mail, whereby the message data content can be determined, to have a descriptor field combined with control data that can be checked; and that given the file format it can be determined if the receiver is able to reconstruct the file and if not that it sends its inability back to the sender.

The suggestion/motivation for doing so would have been that the use of particular modes of communication and data transfer between devices is applicable to any computer network system, regardless of their specific use.

Therefore, it would have been obvious to combine Keller with Hochman to obtain the invention as specified in claims 16 and 18.

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Regarding claim 11, the method and act of forwarding a received message to another user, is inherent in transmission of electronic mail since the command in the email directs the data processing system to implement an action (col. 1, lines 45-52).

Regarding claim 15, Keller discloses that the recipient carries out the request by selecting the action upon receipt of the electronic mail object (Abstract).

Regarding claim 14, Kelly has already been shown to use a user interface, which is equivalent to a terminal, for executing the operations designated by the claim, and rejection is made on the same justification as for that of claims 1 and 2 above.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 703 305-4860. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A Williams can be reached on 703 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Madeleine AV Nguyen". The signature is fluid and cursive, with the first name "Madeleine" and last name "Nguyen" clearly distinguishable.

Madeleine AV Nguyen
Primary Examiner
Art Unit 2626

January 6, 2005